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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,496	02/07/2001	David M. Lubman	UM-06106	8813

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EXAMINER

MAHATAN, CHANNING

ART UNIT PAPER NUMBER

1631

DATE MAILED: 04/08/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/778,496

Applicant(s)

LUBMAN ET AL.

Examiner

Channing S. Mahatan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 28 January 2003 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Attachment for PTO-948*.

DETAILED ACTION

APPLICANTS' ARGUMENTS

Applicants' arguments in Paper No. 8, filed 28 January 2003, have been fully considered but they are not deemed to be persuasive for the reasons set forth below. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

OBJECTION BY DRAFTSMAN

The corrected formal drawings in Paper No. 8, filed 28 January 2003, fails to comply (Refer to "Notice of Draftsperson's Patent Drawing Review, dated 31 March 2003). Applicants are reminded that a PTO-948 was sent with the office action, mailed 26 July 2002, where applicants were informed on the 326 form about the correction of the formal drawings and a time requirement. Applicants are to note this is the second notification of drawing corrections and are required to submit drawing corrections with the time period set for responding to this Office action. Failure to respond to this requirement may result in abandonment of the instant application or a notice of a failure to fully respond to this Office action.

CLAIMS UNDER EXAMINATION

Claims herein under examination are claims 1-34.

Claims Rejected Under 35 U.S.C. § 112 2nd Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-34 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

VAGUE AND INDEFINITE

Claim 1, 10, 23, 28, and all claims dependent therefrom are indefinite due to the lack of clarity of the claim language failing to recite a final process step, which agrees back with the preamble. The preamble(s) states "A method" (claims 1 and 23) and "A system" (claim 28), however the claim recites a final step "analyzing a plurality of fractions...to produce a ...protein profile map"(claims 1 and 23) or "a display apparatus that displays said protein profile map"(claim 28). While minor details are not required in method/process/system claims, at least the basic step must be recited in a positive, active fashion. Further, claim 10 provides for the additional step of "determining the identity of individual bands on said protein profile map" which is confusing as to the goal/intent of the method of claim 1 (i.e. produce a protein profile or determine identity of individual bands). Clarification of the metes and bounds of the claim is requested via clearer claim wording.

Claims Rejected Under 35 U.S.C. § 102

Claims 28, 31, and 34 are rejected under 35 U.S.C. § 102(b) as being anticipated over Chong et al. The rejection is maintained for reasons of record and with further clarification of the basis for rejection.

It is acknowledged that Chong et al. does not explicitly state the exact claim language of "an automated sample handling apparatus configure to receive separated proteins from said reverse phase HPLC separating apparatus" or "a mass spectroscopy apparatus configured to

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receive proteins from said automated sample handling apparatus" (stated by applicants' Paper No. 8, filed 28 January 2003, pages 5-6, lines 27-29 and 1, respectively). However, the claim element(s) of "automation" would have been inherently apparent as described in Chong et al.

The following is a reiteration from the previous office action: "Fractions were analyzed using MALDI-TOFMS to ascertain their molecular weights and observed protein expression (p 1987, Column 1, lines 36-37). Prior to MALDI-TOFMS analysis the cell lysates/sample were treated with external agents (p 1987-1989, "Matrix, substrate and sample preparation" section).

Beckman System Gold® HPLC utilized in this work includes a System Control Center display and keypad permitting the control of not only the device, but also external modules (page 1989, Column 1, lines 16-21)." Particularly, Chong et al. indicates that the Beckman System Gold® HPLC is "automated" by having "a programmable solvent delivery module with a dual-pump.... This module includes a System Control Center display and keypad which permits control of the pump and external modules directly (page 1989, column 1, lines 17-21). Therefore, said element(s) of "automation" would have been inherently apparent in Chong et al. per the device utilized (Beckman System Gold® HPLC).

Appropriate Correction Is Required.

No Claims Are Allowed.

EXAMINER INFORMATION

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and

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1157 OG 94 (December 28, 1993) (See 37 C.F.R. § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Channing S. Mahatan whose telephone number is (703) 308-2380. The examiner can normally be reached on M-F (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward, Ph.D., can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instruments Examiner, Tina M. Plunkett, whose telephone number is (703) 305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

Date:

April 7, 2003

Examiner Initials:

CSM

Marianne P. Allen
MARIANNE P. ALLEN
PRIMARY EXAMINER
~~GROUP 1800~~
AU 1631